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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/092,077 | 03/06/2002 | Christian Wamprecht | Mo6804/LeA 34,849 | 8533 |

157 7590 09/23/2003

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| EXAMINER |
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NILAND, PATRICK DENNIS

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/092,077 | WAMPRECHT ET AL. | |
| | Examiner | Art Unit | |
| | Patrick D. Niland | 1714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/25/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Applicant Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment of 8/25/03 has been entered. Claims 1-12 are pending.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4079028 Emmons et al..

Emmons discloses a polyurethane thickener which is the reaction product of diisocyanate, polyether polyol having 3 or more OH groups, monoalcohol and monoamine. Upon reaction with the isocyanate, the polyetherpolyol will have 4 or more OH groups where it began with 3 OH groups and will possess urethane groups. It is not possible to distinguish this portion of the reaction product of the instant claims and the prior art based on the ingredients which initially formed the polyurethane segment. In other words, making the polyurethane thickener from only the instantly claimed polyether a1 will necessarily give moieties falling within the scope of both a1 and a2 upon reaction with diisocyanate. It is also expected that the patentee's reaction of diisocyanate with the polyether polyol will give a mixture falling within the scope of the instant claim 8, step A. Emmons discloses the combination of monols and amines at column 9, lines 46-68 and column 10, lines 1-19. The degree of picking and choosing required to arrive at the instantly claimed invention is sufficient to remove this reference from the scope of an anticipating reference under the relevant caselaw, such as but not limited to *In re Baird*. See column 2, lines 59-68; column 3, lines 1-68, particularly 31-61; column 4, lines 1-5; column 6, lines 1-68; column 8, lines 1-23 and 48-68; column 9, lines 46-68; and the remainder of the document, particularly the examples. It would

have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combination of ingredients to form the thickener of the patentee because the patentee clearly encompasses such mixtures of reactants and the instantly claimed combination of ingredients would have been expected to give the thickening properties discussed by the patentee. The smaller amount of picking and choosing in the prior art is deemed by the examiner to lead to the choice of the instantly claimed reactant combinations discussed above. Thus, the motivation to combine the reactants taught by one single reference to be useful together and selected from a rather small pool of reactants is deemed to make the instant claims obvious over the cited prior art for the reasons stated above. The applicant's arguments in this regard are therefore not persuasive. It is not seen that the polyurethane thickeners would not necessarily have a softening temperature falling within the scope of that of the instant claims and the instantly claimed softening temperature is typically expected of such polyether based polyurethane thickeners of the molecular weights encompassed by the patentee. It is noted that the method of measuring the instantly claimed softening point is not specified and such methods of measuring polymer softening points lead to different values. The applicant has also not claimed a method of making the polymer but has claimed the polyurethane per se. There is no probative evidence that the instantly claimed reactants do not give the polyurethane argued above nor that they give any unexpected results. The instantly claimed softening temperature is not seen as giving any unexpected results.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/30425 Martz et al..

Martz discloses the instantly claimed thickeners at the abstract; page 3, lines 22-30; page 4, lines 1-30, particularly 14-16 and 24-29; page 5, lines 1-30, particularly 11-17

and 20-26 and the remainder of the document. Upon reaction with the isocyanate, the polyetherpolyol will have 4 or more OH groups where it began with 3 OH groups and will possess urethane groups. It is not possible to distinguish this portion of the reaction product of the instant claims and the prior art based on the ingredients which initially formed the polyurethane segment. In other words, making the polyurethane thickener from only the instantly claimed polyether a1 will necessarily give moieties falling within the scope of both a1 and a2 upon reaction with diisocyanate. It is also expected that the patentee's reaction of diisocyanate with the polyether polyol will give a mixture falling within the scope of the instant claim 8, step A. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combination of ingredients to form the thickener of Martz because the patentee clearly encompasses such mixtures of reactants and the instantly claimed combination of ingredients would have been expected to give the thickening properties discussed by Martz. The smaller amount of picking and choosing in the prior art is deemed by the examiner to lead to the choice of the instantly claimed reactant combinations discussed above. Thus, the motivation to combine the reactants taught by one single reference to be useful together and selected from a rather small pool of reactants is deemed to make the instant claims obvious over the cited prior art for the reasons stated above. The applicant's arguments in this regard are therefore not persuasive. It is not seen that the polyurethane of Martz would not necessarily have a softening temperature falling within the scope of that of the instant claims and the instantly claimed softening temperature is typically expected of such polyether based polyurethanes of the molecular weights encompassed by the patentee. It is noted that the method of measuring the instantly claimed softening point is not specified and such methods of measuring polymer softening points lead to different values. The applicant has also not claimed a method

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of making the polymer but has claimed the polyurethane per se. There is no probative evidence that the instantly claimed reactants do not give the polyurethane argued above nor that they give any unexpected results. The instantly claimed softening temperature is not seen as giving any unexpected results. Arguments regarding "emulsifier" and "thickener" are not persuasive because the instant claims do not recite "thickener" nor exclude "emulsifier".

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/091960. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although the claims differ

somewhat in scope, they overlap such that it would have been obvious to the ordinary skilled artisan at the time of the instant invention to perform the instantly claimed invention from the claims of the copending application because most of the copending claims' invention is that of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The statement by the applicants that they disagree with the examiner is not sufficient to overcome this rejection because their arguments do not specify why they disagree with the examiner nor show that the examiner's position is incorrect. The copending application has been allowed. No arguments have been applied to this rejection. There is no process for holding this rejection in abeyance and it is maintained for the above reasons.

7. This is a Request for Continued Examination of applicant's earlier Application No. 10/092077. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

September 21, 2003



Patrick Niland
Primary Examiner
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